

## **REMARKS**

### **Introduction**

The present application includes claims 8-22, 26, 29-45, wherein claims 8, 11, 16, 21, 34, 41 and 44 are presented in independent form and claims 23-25, 27, and 28 are withdrawn from consideration but depend from a generic independent claim. Applicants acknowledge with appreciation the Examiner's indication that claims 11, 30-33, 44 and 45 contain allowable subject matter. With this Amendment, Applicants have amended claim 21 to place the application in better condition for allowance or for consideration on appeal.

Applicants do not acquiesce in the Examiner's rejections, but instead have elected to make the above-mentioned amendments in an effort to expedite prosecution of this application leading to issuance of a patent. Reconsideration and reversal of the rejection of claims 8-10, 12-22, 26, 29, and 34-43 presented in the Office Action dated December 17, 2004 is respectfully requested in light of the following amendments and arguments.

### **German Reference Translation**

Applicants have submitted a translated copy of German Pat. No. 1041210 in an IDS submitted with this response. The translated copy is used in the arguments below.

### **Prior Art Rejections**

The Examiner rejected claims 21, 22, 26 and 29 under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent Abstract 08-317953 (hereinafter "Japanese Reference"). The Examiner rejected claims 8-9, 12-15 and 34-40 were rejected under 35 § U.S.C. 103(a) as being unpatentable over German Patent 1,041,210 (hereinafter "German Reference"), in view of U.S. Pat. No. 5,580,207 to Kiebooms et al. (hereinafter "Kiebooms"). The Examiner rejected claims 16-20 under 35 U.S.C. § 103(a) as being unpatentable over the Japanese Reference in view of Kiebooms. The Examiner rejected claims 8-9, 12-15 and 34-43 under 35 U.S.C. § 103(a) as being unpatentable over the German Reference in view of the Japanese reference in view of Kiebooms. The Examiner rejected claim 10 under 35 U.S.C. § 103(a) as being unpatentable over the German Reference in view of the Japanese Reference in view of Kiebooms.

#### **§ 102(b) in view of the Japanese Reference**

Applicants respectfully submit that the Japanese Reference simply does not support the Examiner's rejection of claims 21, 22, 26 and 29 under 35 U.S.C. § 102(b) in light of the arguments and amendments made in this response. The case law clearly states that

“anticipation requires that a single prior art reference disclose every limitation of the patent claim.” General Electric Co. v. Nintendo Co., 50 USPQ2d 1910, 1915 (Fed. Cir. 1999) (citing PPG Industries, Inc. v. Guardian Industries Corp., 37 USPQ2d 1618, 1624 (Fed. Cir. 1996)) (“to anticipate a claim, a reference must disclose every element of the challenged claims and enable one skilled in the art to make the anticipating subject matter.”). More particularly, the Federal Circuit has held that the test for anticipation is “[t]hat which would literally infringe if later in time anticipates if earlier than the date of invention.” Lewmar Marine, Inc. v. Barient, Inc., 827 F.2d 744, 3 USPQ2d 1776 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988).

#### Claim 21

Applicants submit that the Japanese Reference fails to teach or suggest a combination including “a propulsion device ... a coupler ... and a handle configured to move the coupler between the coupled and uncoupled positions, the handle being substantially perpendicular to a ~~longitudinal-axis~~ horizontal plane of the bedframe when the coupler is in the coupled position” as required by amend claim 21. The bed transporting device of the Figures 24-28 of the Japanese Reference includes a handle that is **not substantially perpendicular** to the ~~longitudinal-axis~~ horizontal plane of the bedframe when the device is coupled to a bed. As shown in Fig. 25, when the device is attached to a bed the handle 69 simply is not in a position substantially perpendicular to the horizontal plane of the bedframe.

Therefore, Applicants believe that amended claim 21 is in condition for allowance with respect to the Japanese Reference. Removal of the rejection and allowance of claim 21 is respectfully requested. If the Examiner should disagree with the Applicants’ arguments, the Examiner is asked to kindly point out with particularity where the limitation is expressly disclosed.

#### Claims 22, 26, and 29

Claims 22, 26, and 29 depend from claim 21. In that claim 21 is believed to be allowable, claims 22, 26, and 29 are also believed to be allowable. Removal of the rejections and allowance of claims 22, 26, and 29 is respectfully requested.

#### Claims 23-25, 27, and 28

Claims 23-25, 27, and 28 depend from allowable generic claim 21. Accordingly, Applicants submit that claims 23-25, 27, and 28 are appropriate for consideration and are likewise in condition for allowance.

**§ 103 German Reference in view of Kiebooms**

Applicants respectfully submit that the combination of the German Reference and the Kiebooms patent is improper and therefore does not support the Examiner's rejection of claims 8-9, 12-15 and 34-40 under 35 U.S.C. § 103(a). The case law is clear that in order for the U.S. Patent and Trademark Office to "establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." Manual of Patent Examining Procedure (M.P.E.P.) Section 2143.

It is well known that when combining the content of various references "there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant." *In re Dance*, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Raynes*, 28 USPQ2d 1630, 1631 (Fed. Cir. 1993); *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Moreover, the Patent and Trademark Office can satisfy its burden of establishing obviousness "only by showing some *objective* teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teachings of the references." *In re Fine*, 1837 F.2d 1071, 1073, 5 USPQ2d 1596 (Fed. Cir. 1988) (emphasis added) (citations omitted). The Federal Circuit in *In re Fine* stated that a "bald assertion" of substituting an element in a prior art reference would have been within the ordinary skill in the art is insufficient to support a finding of obviousness." *Id.* at 1074.

The Federal Circuit has emphasized the requirement that the prior art must suggest the modifications necessary to achieve the claimed invention. The "mere possibility" that a prior art reference could be modified such that its use would lead to the particular result recited in a claim does not make that recited in the claim obvious "unless the prior art suggested the desirability of such a modification." *In re Ochia*, 71 F.3d 1565, 1570, 37 USPQ2d 1127 (Fed. Cir. 1995). "Obviousness cannot be established by hindsight combination to produce

the claimed invention.” *In re Dance*, 48 USPQ2d at 1637; *In re Gorman*, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

The German reference discloses a non-powered device for moving a bed. The German device is configured to attach to the end of a bed. To transport a bed, the German device is attached to one end of the bed and “the bed is hoisted by tilting the hand lever 15 upward. The hand lever 15 can also be operated effortlessly with the knee. The bed now rests on the rollers 2 and can be driven away.” (German Reference Translation, p.2 ll.9-14.)

Kiebooms discloses a lifting and steering device 1 for moving beds. The lifting device 1 includes a lifting mechanism 4 to lift the underframe of a bed, a steering unit 7, and a traction drive 8. The lifting mechanism 4 lifts one end of the bed and “as a result of which the bed 49, as represented in FIG. 6, is lifted with its two front support wheels 51 from the floor 53.” (Kiebooms, Col. 3 ll. 43-64).

#### Claim 8

In the present case, there is simply no hint or suggestion to modify the apparatus of the German reference to achieve the applicant’s invention of claim 8. First, the German reference fails to disclose “a propulsion device to **power** movement of the patient support...” as required by claim 8. The German reference is a non-powered device. Next, the German reference fails to disclose “...the propulsion device including a pair of drive wheels...” as required by claim 8. The Examiner argues that the German reference is only missing a set of secondary wheels. However, the German reference does not disclose any drive wheels.

There is no motivation to combine the German reference with Kiebooms. The German reference states, “In comparison to said known systems, the invention **seeks a simple and accordingly cost effective** and robust construction that meets the hygienic demands for simplified cleaning and maintenance.” (German Reference Translation, p. 1 l. 22 to p. 2 l. 3, emphasis added). Additionally, the German reference states, “The space-saving design of the bed chassis allows for easy storage when not in use...” (German Reference Translation, p.2 col. 2 ll. 15-16). Kiebooms is a complicated device relative to the German reference. Kiebooms does not disclose space saving features that the German reference discloses. One skilled in the art of non-powered caster devices would not look to a motorized device such as the one in Kiebooms to modify the simple, non-powered and space saving dolly like device in the German reference. In fact, the German reference teaches away from any such combination, since such a combination is not “simple and accordingly cost effective”.

The combined device of the German reference and Kiebooms would be inoperative. The German reference device is attached to one end of a bed. Once the device is locked in place, the opposite end of the bed is raised because “the bed now rests on the rollers 2 and can be driven away.” In Kiebooms, the end of the bed coupled to the propulsion device is lifted, see Kiebooms FIG 6. The end lifted in the German Reference is the opposite end of that lifted in Kiebooms making it impossible to operate as the Examiner describes.

Therefore, Applicants believe that claim 8 is in condition for allowance with respect to the German reference in view of Kiebooms. Removal of the rejection and allowance of claim 8 is respectfully requested. If the Examiner should disagree with the Applicants’ arguments, the Examiner is asked to kindly point out with particularity where the limitation is expressly disclosed.

#### Claims 9, 10, and 12-15

Claims 9, 10, and 12-15 depend from claim 8. In that claim 8 is believed to be allowable, claims 9, 10, and 12-15 are also believed to be allowable. Removal of the rejections and allowance of claims 9, 10, and 12-15 is respectfully requested.

#### Claim 34

In the present case, there is simply no hint or suggestion to modify the apparatus of the German reference to achieve the applicant’s invention of claim 34. First, the German reference fails to disclose “a propulsion device to **power** movement of the patient support...” as required by claim 34. The German reference is a non-powered device. Next, the German reference fails to disclose “...the propulsion device including a pair of drive wheels...” as required by claim 34. The Examiner argues that the German reference is only missing at least one secondary wheel. However, the German reference does not disclose any drive wheels. Additionally, the combination of Kiebooms and the German reference is improper as stated above. Likewise, for the reasons stated above for claim 8, the combination is not appropriate and inoperable. Therefore, the Examiner does not satisfy his burden for rejecting claim 34.

Therefore, Applicants believe that claim 34 is in condition for allowance with respect to the German reference in view of Kiebooms. Removal of the rejection and allowance of claim 34 is respectfully requested. If the Examiner should disagree with the Applicants’ arguments, the Examiner is asked to kindly point out with particularity where the limitation is expressly disclosed.

#### Claims 35-40

Claims 35-40 depend from claim 34. In that claim 34 is believed to be allowable,

claims 35-40 are also believed to be allowable. Removal of the rejections and allowance of claims 35-40 is respectfully requested.

**§ 103 Japanese Reference in view of Kiebooms**

Applicants respectfully submit that the combination of the Japanese Reference and the Kiebooms patent is improper and therefore does not support the Examiner's rejection of claims 16-20 under 35 U.S.C. § 103(a).

**Claim 16**

In the present case, there is simply no hint or suggestion to modify the apparatus of the Japanese reference to achieve the applicant's invention of claim 16. Both the Japanese reference and Kiebooms fail to disclose, teach, or suggest the combination including "a coupler configured to couple the propulsion device to the patient support, **the coupler being configure to be coupled to the patient restraint board**" as required by claim 16. Kiebooms appears to engage the lower portion of a bed and not a patient restraint board. As show in Figs. 25 and 28, coupling mechanism 72 is not configured to couple to a patient restraint board. First, no restraint board is shown in Fig 25. Second, the coupling mechanism 72 is not shown to reach a point at a height of a patient restraint board in order to couple the propulsion device to the bed. Third, even though the coupling mechanism 72 appears to move up and down (see Fig. 28), the coupling mechanism 72 in Fig. 25 is shown only to couple to the lower portion of the bed and not to move to other positions.

There is no motivation to combine Kiebooms with the Japanese reference. The Japanese reference does not show lifting an end of a bed when it is coupled to a bed. Kiebooms, however, describes lifting on an end of the bed. One of ordinary skilled in the art of device coupling would not look to a device that lifts an end of the bed for combination to a device that does not require lifting.

In addition to both references lacking the disclosure that a coupler couples to a patient restraint board, Applicants believe the Examiner simply has not met the burden to show motivation to combine the references.

Therefore, Applicants believe that claim 16 is in condition for allowance with respect to the Japanese reference in view of Kiebooms. Removal of the rejection and allowance of claim 16 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where the limitation is expressly disclosed.

Claims 17-20

Claims 17-20 depend from claim 16. In that claim 16 is believed to be allowable, claims 17-20 are also believed to be allowable. Removal of the rejections and allowance of claims 17-20 is respectfully requested.

**§ 103 German Reference in view of Japanese Reference in view of Kiebooms**

Applicants respectfully submit that the combination of the German Reference, the Japanese reference, and the Kiebooms patent is improper and therefore does not support the Examiner's rejection of claims 8-9, 12-15 and 34-43 under 35 U.S.C. § 103(a).

Claim 8

For the reasons stated above for claim 8, there is simply no hint or suggestion to modify the apparatus of the German reference to achieve the applicants' invention of claim 8. First, the German reference fails to disclose "a propulsion device to **power** movement of the patient support..." as required by claim 8. The German reference is a non-powered device. Next, the German reference fails to disclose "...the propulsion device including a pair of drive wheels..." as required by claim 8. The Examiner argues that the German reference is only missing a set of secondary wheels. However, the German reference does not disclose any drive wheels.

For the reasons stated previously there is no motivation to combine Kiebooms with the German reference. The German reference intends for a simple and cost effective way of attaching casters to a bed frame. Kiebooms is a complicated device relative to the German reference. Additionally, attaching the Kiebooms device to a bed as described in the German reference would create an inoperative device. The beds in the German reference have no casters and require to be lifted with the device of the German reference in order to be suited for movement. One skilled in the art of non-powered caster devices would not look to a motorized device such as the one in Kiebooms to modify the simple, non-powered and space saving dolly like device in the German reference.

There is no motivation to combine the Japanese reference with the German reference nor does the addition of the Japanese reference correct the deficiencies of the German reference and Kiebooms. In addition to not being a simple device, the Japanese reference would not be suited to transport a bed as described in the German reference. The German reference device is intended to be the wheels for a bed that contains no wheels. Simply attaching the Kiebooms device or the Japanese device to the bed described in the German

reference would not allow for easy transportation because the bed does not include wheels or casters.

Therefore, Applicants believe that claim 8 is in condition for allowance with respect to the German reference in view of the Japanese reference in view of Kiebooms. Removal of the rejection and allowance of claim 8 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where the limitation is expressly disclosed.

#### Claims 9, 10, and 12-15

Claims 9, 10, and 12-15 depend from claim 8. In that claim 8 is believed to be allowable, claims 9, 10, and 12-15 are also believed to be allowable. Removal of the rejections and allowance of claims 9, 10, and 12-15 is respectfully requested.

#### Claim 34

As stated above, there is simply no hint or suggestion to modify the apparatus of the German reference to achieve the applicants' invention of claim 34. First, the German reference fails to disclose "a propulsion device to **power** movement of the patient support..." as required by claim 34. The German reference is a non-powered device. Next, the German reference fails to disclose "...the propulsion device including a pair of drive wheels..." as required by claim 34. The Examiner argues that the German reference is only missing at least one secondary wheel. However, the German reference does not disclose any drive wheels.

As discussed above for claim 8, the combination of the German reference and Kiebooms is improper and does not satisfy the Examiner's burden to show obviousness. Additionally, the addition of the Japanese reference does not correct the deficiencies of the combination of Kiebooms and the German reference. For the reasons stated above for claim 8, the Examiner does not satisfy his burden for rejecting claim 34.

Therefore, Applicants believe that claim 34 is in condition for allowance with respect to the German reference in view of the Japanese reference in view of Kiebooms. Removal of the rejection and allowance of claim 34 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where the limitation is expressly disclosed.

#### Claims 35-40

Claims 35-40 depend from claim 34. In that claim 34 is believed to be allowable, claims 35-40 are also believed to be allowable. Removal of the rejections and allowance of claims 35-40 is respectfully requested.



Claim 41

In the present case, there is simply no hint or suggestion to modify the apparatus of the German reference to achieve the applicant's invention of claim 41. First, the German reference fails to disclose "a propulsion device to **power** movement of the patient support, the propulsion device including a motor..." as required by claim 41. The German reference is a non-powered device. Next, the German reference fails to disclose "...the propulsion device including "at least one drive wheel coupled to the motor, and at least one secondary wheel ..." as required by claim 41. The Examiner argues that the German reference is only missing at least one secondary wheel and a motor coupled to a drive wheel. However, the German reference does not disclose any drive wheels.

There is no motivation to combine Kiebooms and/or the Japanese reference with the German reference. The German reference states, "In comparison to said known systems, the invention **seeks a simple and accordingly cost effective** and robust construction that meets the hygienic demands for simplified cleaning and maintenance." (German Reference Translation, p. 1 l. 22 to p. 2 l. 3, emphasis added). Additionally, the German reference states, "The space-saving design of the bed chassis allows for easy storage when not in use..." (German Reference Translation, p.2 col. 2 ll. 15-16). Kiebooms and the Japanese reference are complicated devices compared to the German reference. The German reference is intended to be used to attach wheels to a bed that has no wheels. Additionally, Kiebooms does not disclose space saving features that the German reference discloses. One skilled in the art of non-powered caster devices would not look to a motorized device such as the one in Kiebooms and/or the Japanese reference to modify the simple, non-powered and space saving dolly like device in the German reference.

The combined device of the German reference and Kiebooms would be inoperative. The German reference device is attached to one end of a bed. Once the device is locked in place, the opposite end of the bed is raised because "the bed now rests on the rollers 2 and can be driven away." In Kiebooms, the end of the bed coupled to the propulsion device is lifted, see Kiebooms FIG 6. The end lifted in the German Reference is the opposite end of that lifted in Kiebooms making it impossible to operate as the Examiner describes. Finally, the Japanese reference attached to the bed of the German reference that has no wheels would defeat the purpose of attaching a powered device to a bed.

Additionally, there is no motivation to combine the Japanese reference with Kiebooms. The Japanese reference does not lift an end of a bed when it is coupled to a bed. Kiebooms describes lifting on an end of the bed. One of ordinary skill in the art of device

coupling would not look to a device that lifts an end of the bed for combination to a device that does not require lifting.

Therefore, Applicants believe that claim 41 is in condition for allowance with respect to the German reference in view of the Japanese reference in view of Kiebooms. Removal of the rejection and allowance of claim 41 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where the limitation is expressly disclosed.

Claims 42 and 43

Claims 42 and 43 depend from claim 41. In that claim 41 is believed to be allowable, claims 42 and 43 are also believed to be allowable. Removal of the rejections and allowance of claims 942 and 43 is respectfully requested.

Appeal

To enable the Applicants to better respond to any potential remaining rejections on appeal, the Applicants respectfully request that the Examiner provide additional specificity for the rejections of the dependent claims. Without undue speculation or otherwise, the Applicants are unable to find support for the Examiner's rejections of at least claims 9, 12-15, 17-20, and 22-29 in addition to the comments made above regarding the independent claims.

Applicants respectfully note that according to M.P.E.P. § 1208.02 the fees paid in connection with the Notice of Appeal mailed June 9, 2003 and the Appeal Brief filed mailed July 23, 2003 may be applied to a future appeal in this application, if necessary.

Final Remarks

In view of the foregoing amendments and remarks, Applicants submit that the application is now in condition for allowance. A Notice of Allowance is earnestly solicited.

If necessary, Applicants request that this Response be considered a request for an extension of time for a time appropriate for the response to be timely filed. Applicants request that any required fees needed beyond those submitted with this Response be charged to the account of Bose McKinney & Evans LLP, Deposit Account Number 02-3223.

Respectfully submitted,

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